

Appl. No. 09/474,783
Response Dated August 9, 2005
Reply to Office Action of May 9, 2005

REMARKS

Claims 1, 4-7, 9 and 12-21 are pending in the present application. Claims 1, 7 and 19 have been amended. Reconsideration and allowance of the pending claims are respectfully requested.

Claims 1, 4-7, 9 and 12-21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,619,247 (Russo) in further view of USPN 4,945,563 (Horton). Applicants traverse and request reconsideration and removal of the rejection.

Independent claims 1, 7 and 19 have been amended to recite “the descriptor to indicate whether the storage device may store the received broadcast content prior to viewing, and once stored, a length of time the playback device may reproduce the received broadcast content.” Applicants submit that Russo and Horton fail to teach or suggest at least this feature of independent claims 1, 7 and 19.

As indicated in the Office Action at pages 6-7, “Russo also fails to show that the descriptor information defines the action to store the received broadcast content or reproduce the received broadcast content.” To remedy this admitted deficiency of Russo, the Office Action relies on Horton.

Horton teaches “encrypted programs carry an additional tag or code which is deciphered by the receiver to indicate whether the program may be taped or not. The operator then has the ability to select either view only, or view and tape modes of reception.” *See col. 2, lines 31-35.* According to Horton, “[b]y utilizing this technology in this manner, the inventor herein has succeeded in designing and developing a system

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which is ideal for the distribution of special events such as first run movies." *See* col. 2, lines 52-56.

In view of the above, Applicants submit that Horton clearly fails to teach or suggest at least "the descriptor to indicate whether the storage device may store the received broadcast content prior to viewing" as recited by amended independent claims 1, 7 and 19. Applicants further submit Horton teaches away from the claimed descriptor and to modify Horton to include such a descriptor would be contrary to the principle of operation of Horton.

Moreover, Russo teaches:

In the preferred embodiment, the subscriber has magnetic, optical, or magneto-optical storage means by which program material may be recorded for later playback.

While the *recording itself may take place at any time preceding playback*, billing occurs only when, and if, the subscriber chooses to select a program for replay or actually enjoys the program substantially in its entirety. *See* col. 3, lines 3-9. (emphasis added)

As such, Applicants submit that Russo also teaches away from the claimed descriptor and to include such a descriptor would be contrary to the principle of operation of Russo.

According to the MPEP, three basic criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to

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make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 706.02(j).

Applicants submit that Russo and Horton are insufficient to establish a *prima facie* case of obviousness with respect to amended independent claims 1, 7 and 19. Even if Russo and Horton could be combined, which Applicants do not admit, such combination would still fail to teach or suggest all the claim limitations. Furthermore, there is no suggestion or motivation to modify Russo and Horton to meet all the claim limitations. Namely, any proposed modification to Russo and Horton to meet all the claim limitations would render Russo and Horton unsatisfactory for their intended purposes. Additionally, Russo and Horton do not supply the requisite reasonable expectation of success.

Applicants submit that independent claims 1, 7 and 19 recite novel features not shown by the cited references. Further, Applicants submit that the above-recited novel features provide new and unexpected results not recognized by the cited references. Accordingly, Applicants submit that claims 1, 7 and 19 are not anticipated nor rendered obvious in view of the cited references.

For at least the above reasons, Applicants submit that independent claims 1, 7 and 19 represent patentable subject matter and are thus allowable. Applicants further submit that claims 4-6, 9, 12-18, 20, and 21 are allowable by virtue of their dependency, as well as on their own merits. Removal of the rejection of claims 1, 4-7, 9 and 12- 21 is therefore respectfully requested.

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It is believed that claims 1, 4-7, 9 and 12-21 are in allowable form. Accordingly, a timely Notice of Allowance to this effect is earnestly solicited.

The Examiner is invited to contact the undersigned at 724-933-3387 to discuss any matter concerning this application.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. § 1.16 or § 1.17 to Deposit Account No. 02-2666.

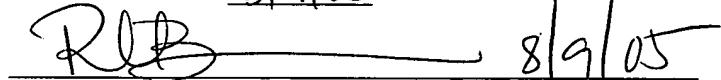
Respectfully submitted,

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Under 37 CFR 1.34(a)

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